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EXAMINER	
HUYNH, THU V	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/676,366	WOOLF ET AL.	
	Examiner	Art Unit	
	Thu V. Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *9/30/03* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: application filed on 09/30/03, which has the benefit of prior provisional filed on 05/19/03.

2. Claims 1-34 are pending in the case. Claims 1, 13, 29 and 31 are independent claims.

Claim Objections

3. Claims 9 and 11 are objected to because of the following informalities:

Regarding dependent claim 9, which is dependent on claim 1, the use of "receiving a request from a computing device corresponding to ***a*** *subscriber user**s***" has typographical error. Appropriate correction is required.

Regarding depend claim 11, which is dependent on claim 10, the use of "***a the*** *page*" at the end of this claim has typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 29, this claim recites the limitation "wherein a request directed towards the published annotation data of a selected author represented in the first set of data is accessed from the second set of data", which renders the claim is vague and indefinite, since the second set of data is annotation data, not request data.

Therefore, the request is accessed from annotation data is unclear. Refer to applicants' specification, page 25, 13-24; page 28, lines 3-15, examiner assumes that annotation data is accessed to exam this claim.

Dependent claim 30 is rejected for fully incorporating the dependencies of its base claim.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-12 and 29-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-12, the claim limitations are not producing a concrete result, since "the data **is deemed** public" based on subjective criteria. Therefore these claims do not produce a practical application and are not statutory subject mater under 35. U.S.C 101.

Regarding claim 12, which is dependent on claim 1, this claim is for a computer-readable medium having computer executable instructions for performing the method of claim 1. However, application's specification indicates that computer-readable medium includes "carrier wave" (see applications' specification, pages 8, line 8 – page 9, line 8), which does not fall within a statutory category of invention. Therefore, claim 12 is not statutory subject mater under 35. U.S.C 101.

Regarding claims 29-30, these claims are for computer-readable medium stored data instruction. However, application's specification indicates that computer-readable medium includes "carrier wave" (see applications' specification, pages 8, line 8 – page 9, line 8), which does not fall within a statutory category of invention. Therefore, claim 12 is not statutory subject mater under 35. U.S.C 101.

Regarding claims 29-30, these claims recite a data structure in combination with computer readable medium. However, these claims do not produce a useful, concrete and tangible result when used in a computer system, since the second set of data is annotation data, not request data. Claiming the request is accessed from annotation data does not produce a useful, concrete and tangible result. Therefore, claims 29-30 are non-functional descriptive material and not statutory subject mater under 35. U.S.C 101.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 5, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin, US 5,909,213, filed 11/28/97.

Regarding independent claim 1, Martin teaches the steps of:

- receiving annotation data of an author that is deemed public and automatically sent from the author's device for publishing (Martin, col.1, lines 44-61; col.5,

lines 1-10 and lines 40-48; user selects tools to draw, type or highlight annotations or objects in application public workspace. Such highlight are received and published to other conference participants on a network); and

- distributing the annotation data to at least one recipient subscriber (Martin, col.5, lines 7-11 and lines 46-48; distributing the highlight to at least one user who joins to the conference).

Regarding claim 5, which is dependent on claim 1, Martin teaches wherein distributing the annotation data to at least one recipient subscriber comprises combining the annotation data with other annotation data on a graffiti page (Martin, col.5, lines 7-11, lines 46-48; entered annotations from users in application public workspace are combined, such as highlighting an image or object is displayed and shared with other conference participants throughout entire conference).

Regarding claim 10, which is dependent on claim 1, Martin teaches persisting the annotation data (Martin, col.5, lines 7-11, lines 30-48; fig.11; annotation persists on conference participants' computers for displaying and sharing among conference participants' computers and one of conference participants is able to annotate in application private workspace as private notes which are not shared and displayed to other conference participants).

Claim 12 is for a computer-readable medium having computer executable instructions performing the method of claim 1 and is rejected under the same rationale (In

order to perform the steps of receiving and distributing the annotation data of claim 1 in a computer conference system, executable instructions must stored in the computer).

10. Claims 13, 15, 17, 21-23, 26-28 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendriks et al., US 2003/0163525 A1, filed 02/22/02.

Regarding independent claim 13, Hendriks teaches the steps of:

- an annotation device that is a client of the server, the annotation device including an annotation program that manages ink annotations input by an author and includes at least one operating mode in which the input ink annotations are to be published (Hendriks; fig.3, [0032], [0038]; a client inputs ink annotations into public recording field 1 and sends to a server for distributing to other clients; "Annotations entered in the recording field are public and distributed to all users"); and
- a send mechanism that sends the published ink annotations to a server for distribution to other clients (Hendriks; fig.3; [0035], " "Send" button cause the input to be sent to the server for distribution among session participants").

Regarding claim 15, which is dependent on claim 13, Hendriks teaches the annotation program displays a page of a publication, and wherein the ink annotations are receive in association with the displayed (Hendriks, figure 3 and 6; [0031]-[0032]; client annotates the document image in parallel with the display of predefined form in public field 1, wherein the predefined form is one page form).

Regarding claim 17, which is dependent on claim 15, Hendriks teaches the annotations program includes at least one other operating mode in which received ink annotations are private (Hendriks, fig.3, [0032], private ink area, such as input field 15 for previewing handwritten strokes).

Regarding claim 21, which is dependent on claim 13, Hendriks teaches wherein one operating mode in which received ink annotations are to be published comprises a graffiti page canvas mode in which annotations are distributed by the server to any other client (Hendriks, fig.6, [0032], [0035], [0038]; ink annotations entered in public record field 1 are distributed by the server to any other client).

Regarding claim 22, which is dependent on claim 13, Hendriks teaches the annotation device includes a receive mechanism that receives annotations published by at least one other client and provides those annotations to the annotation program for presentation (Hendriks, [0035], [0048], [0039]; server receives the annotations from a user and distributes to other user's computer for viewing and/or annotation).

Regarding claim 23, which is dependent on claim 21, Hendriks teaches the annotations device combines the received published annotations with the annotations input by the author for displaying to that author (Hendriks, fig.3; [0035], [0048], [0039]; a user selects a published annotation to add new annotations on public filed 1, which is displayed on user computer).

Regarding claim 26, which is dependent on claim 13, Hendriks teaches the received annotations correspond to a graffiti mode in which any client receives data from any publisher that is operating in the graffiti mode (Hendriks, [0032], [0035]; ink annotations entered from any author in public record field 1 of a session are distributed by the server to any other client who joined in the session).

Regarding claim 27, which is dependent on claim 13, Hendriks taches the annotation device further comprises a mechanism for subscribing to receive the public annotations of another user (Hendriks, [0031], the user joins to interest group).

Regarding claim 28, which is dependent on claim 13, Hendriks teaches the annotation device further comprises a mechanism for filtering which annotations are presented (Hendriks, fig.3, "Search" button; [0050]; searching annotations based on timeline and content)

Regarding independent claim 31, Hendriks teaches the steps of:

- a first annotation device having a first annotation program thereon on which an author inputs public annotation data (Hendriks; fig.3, [0032], [0038]; a client inputs ink annotations into public recording field 1 and sends to a server for distributing to other clients; "Annotations entered in the recording field are public and distributed to all users");
- a second annotation device having a second annotation program thereon which outputs annotation data (Hendriks; fig.3; [0032], [0035], each

participant is able to annotate in recording field and press " "Send" button cause the input to be sent to the server for distribution among session participants" for viewing and annotation);

- a server that receives the public annotation data from the first annotation device and sends the public annotation data to the second annotation device for output via the second annotation program (Hendriks; fig.3; [0035], " "Send" button cause the input to be sent to the server for distribution among session participants").

Regarding claim 32, which is dependent on claim 31, Hendriks teaches the first annotation program outputs annotation data, the second annotation program inputs other public annotation data, and wherein the server receives the other public annotation data from the second annotation device and send the other public annotation data to the first annotation device for output via the first annotation program (Hendriks; fig.3; [0032], [0035], each participant is able to annotate in recording field and press " "Send" button cause the input to be sent to the server for distribution among session participants").

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. **Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin as applied to claims 1 and 5, and further in view of Barsness et al., US 2004/0201633 A1, filed 09/13/01.**

Regarding claim 2, which is dependent on claim 1, Martin does not explicitly disclose annotation data comprises handwritten strokes corresponding to a page of a publication.

Barsness teaches annotation data is handwritten strokes corresponding to a page of a publication (Barsness, [0033], [0050], handwritten annotation).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Barsness' handwritten notes into Martin's annotation, since the combination would have provide different kinds of annotations, such as text, object, drawing, image, or/and handwritten corresponding to a page of a publication.

Regarding claim 6, which is dependent on claim 5, Martin teaches receiving annotation independent of any page of a publication (Martin, col.5, lines 20-29; in private mode, annotation is visible and stored in local user computer only). However, Martin does not teach handwritten strokes.

Barsness teaches annotation data is handwritten strokes (Barsness, [0050], handwritten annotation).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Barsness' handwritten notes into Martin's annotation, since the combination would have provide different kinds of annotations, such as text, object, drawing, image, or/and handwritten for the user to annotate.

13. **Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin as applied to claims 1 and 10, and further in view of McArdle et al., US 5,859,974, filed 07/08/06.**

Regarding claim 3, which is dependent on claim 1, Martin teaches combining the annotation data with other annotation data on a graffiti page (Martin, col.5, lines 7-11, lines 46-48; entered annotations from users in application public workspace are combined, such as highlighting an image or object is displayed and shared with other conference participants throughout entire conference).

However, Martin does not explicitly teach combining the annotation data with other annotation data on a shared canvas.

McArdle teaches combining the annotation data with other annotation data on a shared canvas that is per-page corresponding to a page being presented (McArdle, col.5,

lines 58-65; entered annotations from users in plurality pages in application public workspace are combined, displayed and shared with other conference participants by per-page corresponding to a page being presented).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined McArdle's teaching and Martin's teaching to annotate on a shared canvas, since the combination would have provided Martin's single page as well as McArdle's plurality of pages in a conference to share annotations among conference participants.

Regarding claim 11, which is dependent on claim 10, Martin does not explicitly teach receiving data corresponding to a page of a publication, and wherein persisting the annotation data comprises persisting the annotation data in association with the page.

McArdle teaches receiving data corresponding to a page of a publication, and wherein persisting the annotation data comprises persisting the annotation data in association with the page (McArdle, figures 4 and 5 col.5, line 58 – col.6, line 3; col.6, lines 50-53; col.9, lines 40-49; the user is able to view and manipulate annotation data in each page of a page list in application public workspace so that manipulated annotation data is stored in the page list for sharing/viewing or manipulate by other conference participants' by selecting a public page within public tabs 430).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined McArdle's teaching and Martin's teaching to persist annotation data in association with a page of a publication, since the combination

would have provided Martin's single page as well as McArdle's plurality of pages in a conference to share annotations among conference participants.

14. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and further in view of McArdle as applied to claim 3 above, and further in view of Barsness et al., US 2004/0201633 A1, filed 09/13/01.**

Regarding claim 4, which is dependent on claim 3, refer to the rationale relied to reject claim 3, the limitation of "the shared canvas corresponds to a page of a publication, and wherein receiving annotation data comprises receiving annotation corresponding to the" is included. The rationale is incorporated herein. However, McArdle does not explicitly disclose the annotations are handwritten strokes.

Barsness teaches annotation data is handwritten strokes corresponding to a page of a publication (Barsness, [0033], [0050], handwritten annotation).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Barness's handwritten notes into Martin's annotation, since the combination would have provide different kinds of annotations, such as text, object, drawing, image, or/and handwritten corresponding to a page of a publication.

15. **Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin as applied to claim 1 above and further in view of Rothrock et al., US 5,729,687, filed 12/20/93.**

Regarding claim 7, which is dependent on claim 1, Martin does not teaches accessing a list of subscriber users, and sending the annotation data to at least one subscriber user in the list.

Rothrock teaches accessing a list of subscriber users, and sending the annotation data to at least one subscriber user in the list (Rothrock, col.7, lines 23-44; col.8, lines 44-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Rothrock's teaching into Martin's teaching to access a list of subscriber user, since the combination would have distributed annotations into subscriber user using the list.

Regarding claim 8, which is dependent on claim 7, Martin does not explicitly teach automatically updating a subscriber.

Rothrock teaches automatically updating a subscriber (Rothrock, col.7, lines 23-41; col.8, lines 36-56; col.10, lines 11-18; adding join participant into participant list so that meeting information is synchronized between conference participants).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Rothrock's teaching and Martin's teaching to update a subscriber, since the combination would have maintained the meeting information synchronization between conference participants that include the newly joining participant.

Regarding claim 9, which is dependent on claim 7, Martin does not teach receiving a request from a computing device corresponding to a subscriber user, and wherein sending the annotation data comprises providing the annotation data in response to the request.

Rothrock teaches receiving a request from a computing device corresponding to a subscriber user, and wherein sending the annotation data comprises providing the annotation data in response to the request (Rothrock, col.7, lines 54-67 and col.8, lines 13-23; conference participant requests for viewing or manipulate the annotation information in particular page using page list).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Rothrock's teaching and Martin's teaching to provide annotations in response to the user request, since the combination would have provided the annotation automatically when one page is discussed in a conference as well as in response to a user request when there are plurality of pages in the conference.

16. **Claims 14 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendriks as applied to claims 13 and 31 above, and further in view of Hendler et al., US 2002/0042833 A1, filed 12/29/00.**

Regarding claim 14, which is dependent on claim 13, Hendriks does not explicitly teach the send mechanism comprises a background send thread of the annotation device.

Hendler teaches background process/thread is used to send data to a server while client computer is executing another process (Hendler, [0087]; "while the client computer

410 is executing a first module, a background process may send control data 415 to a server").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hendler's teaching and Hendrik's teaching to include a background thread/process to send data (annotation) to the server, since the combination would have allowed the user to interact with annotation program while sending annotations, such as instead of waiting sending process is completed in order to write another annotation, the user is able to write another annotation while sending a previous annotation.

Regarding claim 33, which is dependent on claim 31, Hendriks teaches the first annotation device sends the public annotation data to the server (Hendriks, [0035]). However, Eintracht does not explicitly teach *a background thread* is used to send the annotation to the server.

Hendler teaches background process/thread is used to send data to a server while client computer is executing another process (Hendler, [0087]; "while the client computer 410 is executing a first module, a background process may send control data 415 to a server").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hendler's teaching and Hendriks' teaching to include a background thread/process, since the combination would have allowed the user to interact with annotation program while sending annotations, such as instead of waiting

sending process is completed in order to write another annotation, the user is able to write another annotation while sending a previous annotation.

17. **Claims 16, 19, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendriks as applied to claims 13 and 15 above, and further in view of Rothrock et al., US 5,729,687, filed 12/20/93.**

Regarding claim 16, which is dependent on claim 15, Hendriks teaches wherein the send mechanism provides an identity of the author and ink data corresponding to the ink annotations to the server (Hendriks, figures 5A, 5B and 5C, "Bob's annotation ink", "The house Bob circled" and "Bob's annotation stroke data" are sent to server in order to distributing to other clients).

However, Hendriks does not explicitly disclose sending an identifier of the page of the publication to the server.

Rothrock teaches page identifier is used in a page list to provide annotation when the user request for viewing or manipulating (Rothrock, col.7, lines 54-67 and col.8, lines 13-23; conference participant requests for viewing or manipulate the annotation information in particular page using page list which contains page identifiers).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Rothrock's teaching and Hendriks' teaching to send the page identifiers of a publication or form for storing in the server, since the combination would have allowed the user to retrieved annotations based on each page of the form or publication to distribute to the user.

Regarding claim 19, which is dependent on claim 13, Hendriks teaches one operating mode in which received ink annotations are to be published comprises a presentation in which annotations are distributed by the server to subscriber (Hendriks, figure 3 and 6; [0031]-[0032]; client annotates the document image in parallel with the display of a predefined form in public field 1. The annotations are distributed to a group of users by the server). However, Hendriks does not explicitly teach a presentation page notation mode.

Rothrock teaches one operating mode in which received annotations are to be published comprises a presentation page notation mode in which annotations are distributed to subscriber (Rothrock, col.7, lines 54-67; col.7, lines 54-67 and col.8, lines 13-23; conference participant requests for viewing or manipulate the annotation information in particular page using page list which contains page identifiers).

Regarding claim 20, which is dependent on claim 13, Hendriks does not disclose wherein one operating mode in which received ink annotations are to be published comprises a shared canvas mode corresponding to a publication page in which annotations are distributed by the server to any other client in association with that publication page.

Rothrock teaches wherein one operating mode in which received ink annotations are to be published comprises a shared canvas mode corresponding to a publication page in which annotations are distributed to any other client in association with that publication page (Rothrock, col.7, lines 54-67; col.7, lines 54-67 and col.8, lines 13-23; entered annotations from users in plurality pages in application public workspace are

combined, displayed and shared with other conference participants by per-page corresponding to a page being presented).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Rothrock's teaching and Hendriks' teaching to annotate on a shared canvas, since the combination would have provided one page per conference as well as plurality of pages per conference to share annotations among conference participants.

Regarding claim 25, which is dependent on claim 13, Hendriks does not teach the received annotations correspond to a shared canvas mode in which any client receives data from any other annotations publisher in association with a publication page.

Rothrock teaches the received annotations correspond to a shared canvas mode in which any client receives data from any other annotations publisher in association with a publication page (Rothrock, col.7, lines 54-67; col.7, lines 54-67 and col.8, lines 13-23; entered annotations from users in plurality pages in application public workspace are combined, displayed and shared with other conference participants by per-page corresponding to a page being presented).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Rothrock's teaching and Hendriks' teaching to annotate on a shared canvas, since the combination would have provided one page per conference as well as plurality of pages per conference to share annotations among conference participants.

18. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendriks as applied to claim 13 above and further in view of Kloubakov et al., US 2002/0103708 A1, filed 01/30/02.**

Regarding claim 18, which is dependent on claim 13, Hendriks does not teach the annotations program provides at least one warning to the author when the operating mode is one in which the input ink annotations are to be published.

Kloubakov teaches different user interface modes are available for a user to activate and a visual indicator tells the user that particular user interface mode is activate (Kloubakov, [007]-[0008]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Kloubakov's teaching and Hendriks' teaching to provide a visual indicator for public and/or private field when such field is activate, since the combination would have indicated the user what field the annotation is entered.

19. **Claims 24 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendriks as applied to claim 21 above and further in view of Nakai et al., US 6,170,016 B1, filed 12/09/98.**

Regarding claim 24, which is dependent on claim 21, Hendriks does not explicitly teach the receive mechanism comprises a background receive thread.

Nakai teaches background process/thread is used to receive data in (Nakai, col.3, lines 44-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Nakai's teaching and Hendrik's teaching to

include a background thread/process to receive data (annotation) from the server, since the combination would have allowed the user to interact with annotation program while receive annotations, such as instead of waiting receiving process is completed in order to write another annotation, the user is able to write another annotation while receiving a annotation from other user.

Regarding claim 34, which is dependent on claim 31, Hendriks teaches a process on the second annotation device that receives the public annotation data from the server (Hendriks, [0035], participant's device receives annotation). However, Hendriks does not explicitly teach *a background thread* is used to receive the annotation from the server.

Nakai teaches background process/thread is used to receive data (Nakai, col.3, lines 44-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Nakai's teaching and Hendriks' teaching to include a background thread/process to receive data (annotation) from the server, since the combination would have allowed the user to interact with annotation program while receive annotations, such as instead of waiting receiving process is completed in order to write another annotation, the user is able to write another annotation while receiving a annotation from other user.

20. **Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

Chastain et al., US 2003/0009459 A1, filed 07/06/01, in view of Altman, US 2004/0163042 A1, filed 02/17/04.

Regarding independent claim 29, Chastain teaches the steps of:

- a first set of data representative of authors of published annotations (Chastain, fig.7, boxes 740 and 750; [0041]; user selects an author from authors for viewing notes);
- wherein a request directed towards the published annotation data of a selected author in the first set of data is provided so that annotations corresponding to the selected author are accessed (Chastain, fig.7, boxes 740 and 750; [0041]; notes corresponding to selected author are received for viewing).

However, Chastain does not explicitly disclose a second set of data for each author corresponding to the published annotation data of that author and the notes are accessed from the second set of data.

Altman teaches a second set of data for each author and each page corresponding to annotation data of that author and annotation data for particular page are retrieved from the second set of data (Altman, fig.6, [0042]; corresponding author ("Creator") who creates note and "Page_No" with annotation data ("Note") so that annotations for particular page are retrieved).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Altman's teaching and Chastain's teaching to include the second set of data, since the combination would have allowed the user to view annotations based on particular page as well as particular author.

21. **Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chastain in view of Altman as applied to claim 29 above and further in view of Bose et al., US 2002/0042830 A1, filed 04/02/01.**

Regarding claim 30, which is dependent on claim 29, Chastain teaches a set of data representative of any subscriber (Chastain, fig.6; [0037]; new note is sent to subscribers in a "Poetry Book Club"). However, Chastain does not explicitly disclose subscriber of each author.

Bose teaches each author has corresponding subscriber (Bose, [0087], [0090]; a CS101 teacher send message to corresponding subscribers using "CS101-Group").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Bose's teaching into Chastain's teaching to maintain a list of subscriber for each author, since the combination would have allowed the user to send notes written by an author to corresponding subscriber.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shiigi, US 2002/0046249 A1, filed 10/15/01, teaches method for crating and sending handwritten or handdrawn message.

Samra, US 6,789,109 B2, filed 08/01, teaches collaborative computer-based production system including annotation.

Gupta et al., US 6,917,965 B2, filed 09/99, teaches facilitating annotation creation and notification via electronic mail.

Gupta et al., US 6,546,405 B2, filed 10/23/97, teaches annotating temporally dimensioned multimedia content.

Pierce et al., US 2003/0214528 A1, filed 03/14/03, teaches method for managing the annotation of document.

Logan et al., US 6,199,076 B1, filed 10/96, teaches public and private annotations.

Pea et al., US 2004/0125133 A1, filed 12/02, teaches method for interactive network sharing of digital video content.

Hales, II et al., US 5,938,723, filed 04/98, teaches re-prioritizing background data transfers in multipoint conference.

Schilit et al., US 6,687,876 B1, filed 12/98, teaches method for maintaining freeform ink annotations on changing views.

Berque, 2004/0201620 A9, filed 07/01, teaches system for knowledge transfer in a group setting.

Kuruoglu et al., US 2002/0078088 A1, filed 12/00, teaches method for collaborative annotation of document.

Eintracht et al., US 6,687,878 B1, filed 03/99, teaches synchronizing local client notes with annotations previously made by other clients notes database.

Rodriguez et al., US 2003/0051128 A1, filed 09/02, teaches background process to send update data to server.

J. Mark Pullen, "Synchronous Distance Education and the Internet", published 98, pages 1-11.

Moran et al., "Pen-Based Interaction Techniques For Organizing Material on an Electronic Whiteboard", published 97, pages 45-54.

Lee et al., "Developing Collaborative Applications On the World Wide Web", published 98, pages 141-142.

Kuo et al., "A Synchronization Scheme for Multimedia Annotation", published 97, pages 594-598.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V. Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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March 20, 2006